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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,725	04/02/2004	Lawrence M. Lubbers	TTL-04US	1018
26875 7590 09/30/2008 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202				
EXAMINER				
WOO, JULLAN W				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,725

Applicant(s)

LUBBERS ET AL.

Examiner

Julian W. Woo

Art Unit

3773

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-72 and 111-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-72 and 111-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 124 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe a housing that is flexible.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 68-70, 72, 111-114, 116-119, and 121-123 are rejected under 35 U.S.C. 102(b) as being anticipated by Moreira (2,243,717). Moreira discloses, at least in figure 1, an apparatus including an elongate housing (15) having a first end, a second end, the first end configured to receive a soft tissue anchor; a handle (proximal portion of 15) disposed proximate the second end of the housing, a tubular shaft (12) disposed

within the housing and having an inner bore, a driving member (14) disposed within the shaft and movable along the inner bore and having an inner channel, an inner member (20) disposed within the shaft and movable along the inner bore, the inner member having an inner channel sized to receive an elongate tensile member or a shuttle member; a first actuating member (proximal portion of 12) coupled to the shaft, and a second actuating member (19) coupled to the inner member; where the first and second actuating members are disposed proximate (i.e., near) the second end of the housing, where the apparatus includes a passage for receiving an elongate tensile member (10), where manipulation of the second actuating member extends the elongate tensile member and the inner member beyond the first end of the housing, and where the apparatus includes a soft tissue anchor (S). With respect to claim 111, the handle is at the proximal portion of element 15, while the shaft is deemed to be element 20, which configured to extend beyond the first end of the housing. Also with respect to claim 111, the driving member is deemed to be element 12, while the first actuating member is deemed to be the proximal portion of element 12. Note: The introductory statement of intended use ("for repairing soft tissue") has been carefully considered but deemed not to impose any structural limitations on the claims patentably distinguishable over Moreira's device, which is capable of being used as claimed if one desires to do so.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 71, 115, and 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreira (2,243,717) in view of Ross et al. (5,152,765). Moreira discloses the invention substantially as claimed, but does not disclose a needle coupled proximate a distal end of the elongate tensile member, and where the inner member is engageable with the needle to extend the elongate tensile member and the needle past a first end of the housing. Ross et al. teach, at least in figures 6-11 and col. 6, lines 6-44, an elongate tensile member (86) with a needle (88 or 94) coupled to its distal end. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Ross et al., to include a needle with the elongate tensile member of Moreira. Such a modification would allow the apparatus of Moreira to easily penetrate soft tissue and bone for the anchoring of soft tissue to bone or for the implantation of a fracture-reducing screw in bone.
7. Claim 124 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moreira (2,243,717) in view of Carignan et al. (6,319,257). Moreira discloses the invention

substantially as claimed. Carignan et al. teach, at least in figure 1 and in col. 6, lines 35-39; a surgical device with a tubular housing (16) comprising a flexible material, such as plastic, aluminum, stainless steel, and/or titanium. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the housing of Moreira, so that is flexible, i.e., formed of a flexible material. Such a material, as taught by Carignan et al., would be lightweight, strong, and corrosion-resistant.

Response to Amendment

8. With respect to arguments regarding the rejection under 35 U.S.C. 102(b) and based on Moreira: As shown in the rejection above, Moreira indeed discloses an "inner member" as claimed, as well as a "shaft" as claimed (with respect to claim 111). The indication of allowable subject matter in claim 71 is hereby withdrawn in view of new grounds of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Julian W. Woo/
Primary Examiner, Art Unit 3773

October 1, 2008